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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,351	03/15/2001	Neal Brooks	58593.000006	3436

7590

02/10/2005

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EXAMINER

CRAIG, DWIN M

ART UNIT

PAPER NUMBER

2123

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,351

Applicant(s)

BROOKS ET AL.

Examiner

Dwin M Craig

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1-30** have been cancelled. **Claims 31-33** have been presented for Examination.

Response to Arguments

2. Applicants arguments presented in the 10/26/2004 response have been fully considered.

The Examiner's response is as follows.

- 2.1 As regards the Applicant's amended claim language.

It is noted by the Examiner that the scope of the original claims has changed, specifically, taking independent claim 1 for example, the previous claims were limited to the set of operating variables written to the removable media and then operating an emulation on a second machine based on those variables. The new independent **Claim 31** reads in part, "*the modified operating environment of the second machine emulates the first operating environment of the first machine independent of the operation of the first machine*;" The Examiner notes that the previous claim language did not include the limitation linking the independence of the operation of the first machine. The scope of the claimed subject matter has changed.

The Examiner withdraws the earlier 35 U.S.C. 103(a) rejections of claims 1-30, as these rejections are moot in light of Applicant's cancelled claims and submission of new claims with expanded scope.

Based on the Applicant's new claim language and expanded scope, an updated search has revealed new art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. **Claims 31-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Solomon U.S. patent 6,269,409** in view of **Sanders U.S. patent 5,734,831**.

3.1 As regards independent **Claim 31** the *Solomon* reference discloses a method of emulating an operating environment (**Figure 1B item 152, Figure 1C item 172, Figure 3, Figure 4**), via recordable media (**Col. 7 Lines 45-56**) the limitations of terminating the emulation and restoring the operating environment are *inherent* to the *Solomon* reference. The Examiner notes that a use of the *Solomon* emulation would at some point wish to terminate the emulation and at the same time have the underlying UNIX environment continue to function, this is the functional equivalent of terminating the emulation and restoring the previous settings.

The *Solomon* reference does not expressly disclose the connecting a second machine to the removable media, or modifying a second operating environment of the second machine based

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on stored operating environmental variables so the modified operating environment of the second machine emulates the first operating environment of the first machine independent of the operation of the first machine.

The *Saunders* reference discloses connecting a second machine to the removable media (**Figure 1 item 110 & 120**), and modifying a second operating environment of the second machine based on stored operating environmental variables so the modified operating environment of the second machine emulates the first operating environment of the first machine independent of the operation of the first machine (**Figure 2B items 240, 250, 260, Col. 4 Lines 9-47**) and emulation (**Figure 8, Col. 6 Lines 14-23**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the UNIX emulation methods of the *Solomon* reference with the UNIX configuration methods of the *Saunders* reference because, by automating the task of configuring the computer system which will perform the emulation, the need for highly skilled people to perform the task, which involves a great deal of very detailed knowledge and expertise, can now be performed by people with a relatively low level of knowledge (**Sanders, Col. 1 Lines 53-57**), further, it would be desirable to use the emulation method disclosed in the *Solomon* reference because they provide a method to run the popular WindowsTM Operating environment on an existing UNIX workstation (**Solomon Col. 2 lines 5-11**).

3.2 As regards dependent **Claim 32** the *Solomon* reference discloses removable media (**Col. 7 lines 45-56**).

Allowable Subject Matter

4. **Claim 33** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Claims 1-30 have been cancelled. Claims 31-32 have been rejected. Claims 33 is objected to.

5.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **U.S. Patent 6,772,419** discloses an emulation method, **U.S. Patent 6,615,365** discloses a methods of storing user partitions on a recordable media (**Figures 1-3**), **U.S. Patent 6,633,977** discloses a method configuring a plurality of computer systems using a recordable media (**Figure 2**).

5.2 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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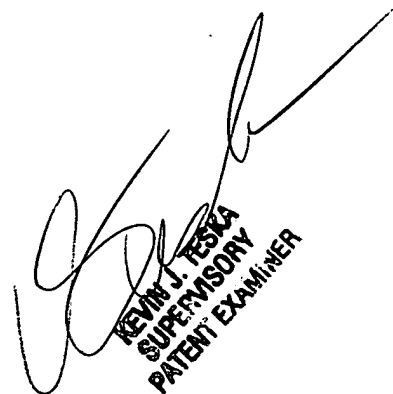
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5.3 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwain M Craig whose telephone number is 703 305-7150. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 703 305-9704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMC



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